



**UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/210,539	12/14/98	ISHIBASHI	

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IM52/0327

EXAMINER
EGWIN, K

ART UNIT	PAPER NUMBER
1713	

DATE MAILED: 03/27/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/210,539

Applicant(s)

ISHIBASHI ET AL.

Examiner

Dr. Kelechi C. Egwim

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 February 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,5-8 and 10-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,5-8 and 10-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

DETAILED ACTION

Continued Prosecution Application

1. The request filed on 2/23/01 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 09/210,539 is acceptable and a CPA has been established. An action on the CPA follows.
2. Due to amendments by applicant, the previous objections and 112 rejections of record have been overcome and are hereby withdrawn.

Claim Rejections - 35 USC § 102/103

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
4. Claims 1, 2, 5, 6, 8 and 10-13 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, 35 U.S.C. 103(a) as being unpatentable over Obuchi et al. or Tsai et al., for reasons cited in the previous Office action.
5. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Obuchi et al. or Tsai et al., each independently as applied to claims 1, 2, 4-6, 8 and 10-12 above, and further in view of Yamada et al., for reasons cited in the previous Office action.

Response to Arguments

6. Applicant's arguments filed 2/23/01 have been fully considered but they are not persuasive.

7. Regarding Applicant's arguments that Obuchi et al. is silent regarding the diameter of the dispersed components, as stated in the Final rejection, the particle diameters claimed by applicant would have been within the range of particle diameters for the dispersed PLA in Obuchi et al., given that the compositional ranges and the processes used in preparing the articles overlap in scope with the present invention. The 102/103 rejection is not based on the suggestion (or motivation) of the claimed diameter in the articles of Obuchi et al., but rather on the inherency of the claimed diameters give the compositional ranges taught by the prior art and give the known immiscibility of PLA with the recited aliphatic polyesters. As such, the composition of Obuchi et al. is essentially the same as the claimed composition.

It is noted that in Applicant's examples (page 37, lines 1-7 of the present specifications), the components of the articles are simply mixed within a given ratio in order to obtain the claim articles. This same process described in the prior art would have resulted in the claimed articles. There is no special procedure taught by applicant for attaining these particular diameters of PLA, other than mixing within the respective ratios.

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8. Regarding the 75% of aliphatic polyester in Obuchi et al., in col. 4, lines 13-21, col. 6, lines 41-53, and col. 9, lines 3-45, Obuchi et al. teach a variety of articles made from a thermoplastic composition comprising a biodegradable resin containing **25-75%** of PLA and **25-75%** of a butylene succinate polymer (aliphatic polyester). This overlaps with Applicant's "55 to 90% by weight" of aliphatic polyester.

9. Regarding the argument that the Bionolle 1020 (obtained from the same vendor as Applicant) in the articles of Tsai et al. does not contain talc, Applicant makes it clear in the original specifications that this grade of Bionolle presently used comprised 30% talc. In page 36, lines 17-23 and col. 37, lines 3-7 of the present specifications, Applicant explicitly defines Bionolle 1020 as a "commercially available" **"talc-containing (30%) grade of the aliphatic polyester type biodegradable resin** made by Showa Highpolymer Co., Ltd and **sold under the trademark designation of 'Bionolle' #1020"**. As such, the composition of Tsai et al. is also essentially the same as the claimed composition.

Even if assuming that the commercially available Bionolle 1020 did not contain the talc as recited in Applicant's specifications, it would still have been obvious to one of ordinary skill in the art, at the time the invention was made, to arrive at the same inventive composition because the disclosure of the inventive subject matter appears within the disclosure of prior art.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Kelechi C. Egwim whose telephone number is (703) 306-5701. The examiner can normally be reached on M-T (7:30-6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (703) 308-2450. The fax phone numbers for the organization where this application or proceeding is assigned are 305-3599 for regular communications and 305-3599 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)305-8183.

KCE

KCE
March 26, 2001


DAVID W. WU
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700